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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,743	05/26/2005	Hiroyuki Osada	1261-0156PUS1	6909
2292 7590 07/25/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER CHENG, KAREN	
			ART UNIT 1626	PAPER NUMBER
			NOTIFICATION DATE 07/25/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/516,743	Applicant(s) OSADA ET AL.	
	Examiner Karen Cheng	Art Unit 1626	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

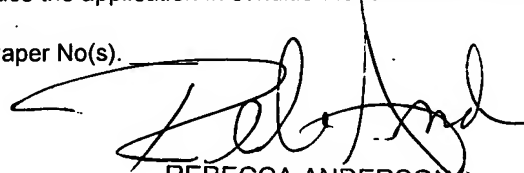
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

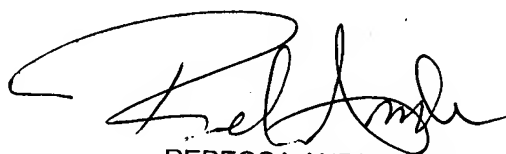
#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s).  
13. ☐ Other: \_\_\_\_\_.

  
REBECCA ANDERSON  
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: The declaration under 37 CFR 1.132 filed 04/24/07 is insufficient to overcome the rejection of claims 3 and 8 based upon 35 USC 103(a) as set forth in the last Office action because the objective evidence of nonobviousness is not commensurate in scope with the claims which the evidence is offered to support. In order for the prior art rejections to be overcome, the scope of the showing must be commensurate with the scope of the claims. See *In re Peterson*, 315 F.3d 1325, 1330, 65USPQ2d 1379 (Fed. Cir. 2003). Specifically the claims include a compound represented by the formula wherein R is a linear, branched, or cyclic alkyl having 4 carbon atoms. However applicant's declaration only shows comparison of activity of the compound wherein R is methyl (linear C1 alkyl) and t-butyl (branched C4 alkyl). Thus the unexpected inhibition of the growth of neuroblastoma cells has only been shown by a compound wherein R is a branched C4 alkyl. No evidence of unexpected results for a linear alkyl with 4 carbon atoms (i.e. when R is a n-butyl group) has been shown. Applicants have failed to show that the unexpected results would occur over the entire scope of the claims, specifically when R is a linear alkyl having 4 carbons. Thus it cannot be determined if unexpected inhibition of the growth of neuroblastoma cells would be found with compounds in which R is a linear alkyl having 4 carbons or if such a result is found only when R is a branched alkyl group. The showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. In *re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). Since the objective evidence of nonobviousness is not commensurate in scope with the claims which the evidence is offered to support, the rejections under 35 USC 103 (a) are maintained.

Additionally the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 3 is considered to have new matter as the definition of the linear, branched, or cyclic alkyl group of R has been amended from 2 to 6 carbon atoms to 4 carbon atoms. Applicant cannot exclude that which applicant has not specifically included, i.e. applicant cannot delete 2, 3, 5 and 6 carbons from their definition of R as there is no support in applicants' originally filed disclosure for the range of cyclic alkyl group of 4 carbons as this group has not been prepared or recited. According to *In re Ruschig* 379 F.2d 990, 154 USPQ 118 (CCPA 1967) and *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1326, 56 USPQ2d 1481, 1486 (Fed. Cir. 2000)., "Ruschig makes clear that one cannot disclose a forest in the original application, and then later pick a tree out of the forest and say "here is my invention." In order to satisfy the written description requirement, the blaze marks directing the skilled artisan to that tree must be in the originally filed disclosure." While *In re Johnson*, 558 F.2d 1008, 195 USPQ 187, 196 (CCPA1977) shows us that if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims, applicant has not excluded alternative elements that are positively recited in the specification but has limited the genus disclosed in the specification to a specific sub-genus which has no basis in the original disclosure, i.e. there are no examples found, nor a sub-genus found in the specification which includes the subgenus of cyclic alkyl group of 4 carbon atoms.



REBECCA ANDERSON  
PRIMARY EXAMINER